



Paper No. 48

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In re Application of:
Goodman et al.
Application No.: 08/971,172
Filed: November 14, 1997
Attorney Docket No.: B98-006-2

OFFICE OF PETITIONS
DECISION ON PETITION

This is a decision on the petition filed by facsimile transmission on May 8, 2003, to invoke the supervisory authority of the Director to review and revise or expunge the decision by the Group Director of Technology Center 1600 (Group Director) of April 28, 2003, which decision denied the petition of March 6, 2003 to rescind the Group Director's decision of January 22, 2003 and the examiner's answer of October 1, 2002.

The petition to invoke the supervisory authority of the Director to review and revise the Group Director's decision of April 28, 2003, and to rescind the Group Director's decision of January 22, 2003 and the examiner's answer of October 1, 2002, is **dismissed** as moot.

The petition to expunge the Group Director's decision of April 28, 2003 is **denied**.

Petitioners request review of the Group Director's decision of April 28, 2003 on the basis that "it contaminates this record with numerous misstatements of readily ascertainable facts, improperly burdening and prejudicing the pending review." Specifically, petitioners contend that the decision: (1) at 3 lines 14-15 incorrectly asserts that applicants claimed that sequences 001632 and U88183 were released on April 21, 1997; (2) at 3 lines 17-19, incorrectly asserts that sequence 001632 includes U88183; (3) at 3 lines 27-29, incorrectly assigns to applicants a remark made by the examiner (that sequence 001632 contains the same sequence as U88183); (4) incorrectly asserts that applicants have equated a "last updated" date with a creation date; (5) at 6-7, incorrectly alleges that the "last updated" date is merely the date on which some access or updating of data was made; and (6) incorrectly misrepresents applicants' statements in the record.

The issue before the Group Director was the petition to rescind the examiner's answer of October 1, 2002, on the basis that the examiner had allegedly introduced new evidence in the form of an electronic mail message string in the examiner's answer of October 1, 2002 to support his prior allegation of a publication date of February 14, 1997 for the U88183 sequence. Petitioners contended that this action denied petitioners an opportunity to confront or rebut the new evidence. The Board of Appeals and Interferences (BPAI), however, remanded the above application in a decision of May 14, 2003, on the basis of the examiner's answer referring to more than one prior Office action, and required *vacatur* of the examiner's answer of October 1, 2002. Since the examiner's answer of October 1, 2002 is to be vacated, there are no outstanding

issues regarding the examiner's answer of October 1, 2002 to be further reviewed. Therefore, petitioners' request for review of the Group Director's decision refusing to rescind the examiner's answer of October 1, 2002 is moot.

Expungement of any Office communication (much less a Group Director's decision) from the file of an application is an extraordinary action by the USPTO. Given the longstanding USPTO policy that the administrative record of any application file should accurately reflect its prosecution history, a revision or expungement of an Office communication would only be justified where that Office communication contained inappropriate statements that were not suitable for retention in the administrative record. Cf. 37 CFR 1.3 (requires that applicants must conduct their business with the USPTO with decorum and courtesy). Inspection of the Group Director's decision does not reveal that it contains any inappropriate statements that are unsuitable for retention in the administrative record of this application. An applicant's contention that an Office communication contains factually and legally incorrect statements is not an appropriate basis for expungement of the Office communication.

This file is being returned to Technology Center Art Unit 1647 for consideration of the remand by the BPAI of May 14, 2003.

Telephone inquiries related to this decision should be addressed to Petitions Examiner Brian Hearn at (703) 305-1820.



Stephen G. Kunin
Deputy Commissioner for
Patent Examination Policy

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